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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/840,975 | 04/25/2001 | Gholam A. Peyman | 41697 | 5337 |

1609 7590 11/19/2002

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| EXAMINER | |
| GIBSON, ROY DEAN | |
| ART UNIT | PAPER NUMBER |

3739

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/840,975 | PEYMAN, GHOLAM A. |
| | Examiner | Art Unit |
| | Roy D. Gibson | 3739 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 November 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 20-25 is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) 15-19 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 April 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, an apparatus is recited and in dependent claims 2-13, a system as claimed in claim 1 is recited. The examiner suggests changing apparatus in claim 1 to system.

As to claims 2 and 7, since the material delivery device is claimed as being "adapted" to deliver a fluid, then it would appear that the fluid type is not being claimed. Thus in claims 2 and 7, which provide further limitations regarding the fluid, it is unclear if now the type and concentration, etc. are being claimed as part of the apparatus or claimed in combination with the apparatus. Clarification is required.

Claim 5 recites the limitation "said indocyanine portion" in line 3. There is insufficient antecedent basis for this limitation in the claim. The examiner suggests inserting "green" after indocyanine to correct this.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Bretton (5,885,279).

As to claim 1, Bretton discloses an apparatus comprising an energy emitting device (external laser and internal optical fiber in probe 10), and a material delivery device adapted to deliver a fluid (irrigation lumen within the probe 10 and col. 7, lines 8-44).

As to claims 2 and 7, the fluid type and characteristics are not given any patentable weight since the fluid is not positively recited as part of the invention in claim 1, but merely a fluid used in an intended use of the apparatus.

As to claims 6 and 8, Bretton discloses the energy emitting device comprises a fluid container (inflatable tip which expands with the inflow of a fluid and is capable of containing the same fluid that is delivered to the cells: col. 7, lines 17-26).

As to claim 11, Bretton discloses that energy device and material device are configured as a unitary device (col. 7, lines 39-44).

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Latina (5,549,596). Latina discloses a method for treating choroidal cells in the eye of a patient comprising the steps of:

positioning an energy emitting device at a position in relation to the choroidal cells; and causing the energy emitting device to emit the energy to heat the choroidal cells to kill the cells (col. 5, lines 34-col. 6, line 16).

Claims 1, 6, 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Berlin (4,846,172).

As to claims 1, 6 and 10, Berlin discloses an apparatus comprising an energy emitting device (external laser and internal optical fiber in probe B), and a material delivery device adapted to deliver a fluid (infusion fluid is passed through port 48 into container or lumen 52 and out the end through the opening as shown in Figures 5-8 and col. 8, line 48-col. 9, line 16).

As to claims 11 and 12, Berlin discloses that energy device and material device are configured as a unitary device with a container (jacketed space 52 and col. 8, lines 48-62).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bretton.

Bretton fails to disclose a laser diode as the source, however, the examiner maintains that it would have been obvious to a skillful artisan to modify the device of Bretton with a laser diode source as a well known alternative equivalent to a "laser" as recited in col. 7, lines 22-26 as a means to heat the tissue to be treated.

Allowable Subject Matter

Claims 20-25 are allowed.

Claims 4, 5, 9 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 15-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fuller et al. (5,968,033) disclose an optical delivery system for treating tissue comprising an energy source and a material delivery device for fluid.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 703-308-3520. The examiner can normally be reached on M-F, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Art Unit: 3739

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

November 15, 2002



Roy Gibson
Primary Examiner
Art Unit 3739